ESTTA Tracking number:

ESTTA484623 07/20/2012

Filing date:

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

#### **Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

## Opposer Information

Name	Societe des Produits Nestle S.A.
Granted to Date of previous extension	07/22/2012
Address	Case Postale 353 1800 Vevey, SWITZERLAND

Attorney	A. John P. Mancini
information	Mayer Brown LLP
	1675 Broadway
	New York, NY 10019
	UNITED STATES
	IPDocket@mayerbrown.com, jlwhite@mayerbrown.com

# **Applicant Information**

Application No	85302689	Publication date	01/24/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	07/22/2012
Applicant	BB Endeavors LLC P.O. Box 2088 New York, NY 10013 UNITED STATES		

# Goods/Services Affected by Opposition

Class 005.

All goods and services in the class are opposed, namely: Nutritional bars for use as a meal replacement; nutritional shakes for use as a meal replacement; meal replacement snacks

Class 030

All goods and services in the class are opposed, namely: Sauces

## **Grounds for Opposition**

Priority and likelihood of confusion Trader	emark Act section 2(d)
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# Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4031576	Application Date	02/18/2011
Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	SKINNY COW		

Design Mark						
	SKINNY COW					
Description of Mark	NONE					
Goods/Services	Class 030. First use: First Use Ice cream, low fat ice cream,					
U.S. Registration No.	3697164	3697164 Application Date 09/19/2005				
Registration Date	10/13/2009	Foreign Priority Date	NONE			
Word Mark	GET THE SKINNY					
	GET TE	IE SK	INNY			
Description of Mark	NONE					
Goods/Services	Class 030. First use: First Use: 2007/12/01 First Use In Commerce: 2007/12/01 Low fat ice cream; frozen dairy novelties; frozen dairy confections; frozen dairy desserts; frozen low fat dairy desserts					
U.S. Registration No.	4026256	Application Date	03/17/2011			
Registration Date	09/13/2011	Foreign Priority Date	NONE			

Word Mark

SKINNY COW

Design Mark	SkinnyCow
Description of Mark	The mark consists of a black and white reclining cow with a yellow tape measure atop a pink banner that is outlined in yellow, with the words "SKINNY COW" in white. The cow has a pink nose and red lipstick.
Goods/Services	Class 030. First use: First Use: 2005/11/28 First Use In Commerce: 2005/11/28
	Ice cream, low fat ice cream, low fat ice cream sandwiches, frozen confections

U.S. Registration No.	3403713	Application Date	12/03/2004
Registration Date	03/25/2008	Foreign Priority Date	NONE
Word Mark	THE SKINNY COW		
Design Mark	the Skinny	Cow	
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2005/11/28 First Use In Commerce: 2005/11/28		
			n dairy novelties; frozen dairy I fat and low fat dairy desserts

U.S. Registration No.	3360435	Application Date	12/03/2004
Registration Date	12/25/2007	Foreign Priority Date	NONE
Word Mark	THE SKINNY COW		

Design Mark	The Skinny Cow
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2005/12/29 First Use In Commerce: 2005/12/29 Milk

U.S. Registration No.	2324506	Application Date	04/21/1999
Registration Date	02/29/2000	Foreign Priority Date	NONE
Word Mark	THE "SKINNY COW"		
Design Mark	The Swinty Cour"		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1994/01/00 First Use In Commerce: 1994/01/00 Low fat ice cream		

U.S. Registration No.	4165917	Application Date	02/18/2011
Registration Date	06/26/2012	Foreign Priority Date	NONE
Word Mark	SKINNY COW		
Design Mark	SKIN	NY (	COW
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use Candy; chocolate confection		lse In Commerce: 2011/05/01

U.S. Registration No.	4092390	Application Date	02/23/2011
Registration Date	01/24/2012	Foreign Priority Date	NONE
Word Mark	SKINNY COW		
Design Mark	SkinnyCo		
Description of Mark	The mark consists of a reclini words "SKINNY COW".	ng cow with a tape n	neasure atop a banner with the
Goods/Services	Class 030. First use: First Use Candy; chocolate confections		lse In Commerce: 2011/05/01

U.S. Registration No.	4092386	Application Date	03/16/2011
Registration Date	01/24/2012	Foreign Priority Date	NONE
Word Mark	SKINNY COW		
Design Mark	SkinnyCo	W	
Description of Mark		ıtlined in yellow, with t	ow with a yellow tape measure he words "SKINNY COW" in
Goods/Services	Class 030. First use: First Use Candy; chocolate confection		lse In Commerce: 2011/05/01

U.S. Application No.	85268774	Application Date	03/16/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SKINNY COW		

Design Mark	SkinnyCow
Description of Mark	The mark consists of a black and white reclining cow with a yellow tape measure atop a pink banner that is outlined in yellow, with the words "SKINNY COW" in white. The cow has a pink nose and red lipstick.
Goods/Services	Class 029. First use:
	Milk-based beverages; flavored milk-based beverages

U.S. Application No.	85249923	Application Date	02/23/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SKINNY COW		
Design Mark	SkinnyGo	W	
Description of Mark	The mark consists of a reclini words "SKINNY COW".	ng cow with a tape m	neasure atop a banner with the
Goods/Services	Class 029. First use: Milk-based beverages; flavored milk-based beverages		

U.S. Application No.	85246148	Application Date	02/18/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SKINNY COW		

Design Mark	SKINI	VY (	COW
Description of Mark	NONE		
Goods/Services	Class 029. First use: Milk-based beverages; flavore	ed milk-based bevera	iges
U.S. Application No.	85268630	Application Date	03/16/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SKINNY COW		•
Design Mark	Skinny Co		
Description of Mark	The mark consists of the styliz swirled underline.	zed words "SKINNY (	COW" in pink with a pink
Goods/Services	Class 029. First use:		
	Milk-based beverages; flavore	ed milk-based bevera	iges
	Class 030. First use:		
	Candy; chocolate confections sandwiches, frozen confection		ce cream, low fat ice cream

U.S. Application No.	85617973	Application Date	05/06/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SKINNY COW		

Design Mark	Skinny
Description of Mark	The mark consists of a piece of chocolate in the shape of a cow spot with rounded corners, indented sides, and a raised border. The words SKINNY COW appear in stylized letters on top of the piece.
Goods/Services	Class 030. First use:
	Candy; chocolate confections

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SKINNY COW		
Goods/Services	products including low fat ice cream, candy, chocolate, milk, and frozen confections		

Related Proceedings	91203331
Attachments	85246139#TMSN.jpeg (1 page) (bytes) 78715744#TMSN.jpeg (1 page) (bytes) 85269449#TMSN.jpeg (1 page) (bytes) 78979610#TMSN.jpeg (1 page) (bytes) 78526758#TMSN.jpeg (1 page) (bytes) 75688594#TMSN.gif (1 page) (bytes) 85976346#TMSN.jpeg (1 page) (bytes) 85975810#TMSN.jpeg (1 page) (bytes) 85975278#TMSN.jpeg (1 page) (bytes) 85268774#TMSN.jpeg (1 page) (bytes) 85249923#TMSN.jpeg (1 page) (bytes) 85246148#TMSN.jpeg (1 page) (bytes) 85268630#TMSN.jpeg (1 page) (bytes) 85268630#TMSN.jpeg (1 page) (bytes) 85617973#TMSN.jpeg (1 page) (bytes) Skinny Cow_Notice of Opposition - Skinnygirl Nutritional Bars _702677627_2pdf (18 pages) (7689680 bytes)

# **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jason L. White/
Name	Jason L. White
Date	07/20/2012

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Filed: April 22, 2011		
For the mark: SKINNYGIR	L	
Published in the Official Gaz	zette on: Janu	uary 24, 2012
go grizzi pro		
SOCIÉTÉ DES		
PRODUITS NESTLÉ S.A.,		)
, , , , , , , , , , , , , , , , , , ,		)
	Opposer,	
		)
V.		) Opposition No.: Pending
		)
BB ENDEAVORS LLC,		)
		)
	Applicant.	)

In the matter of trademark application Serial No. 85/302,689

#### **NOTICE OF OPPOSITION**

Opposer, Société des Produits Nestlé S.A. (hereinafter "Nestlé"), believes that it is being and will continue to be damaged by registration of the mark SKINNYGIRL in application 85/303,728 for use in connection with "nutritional bars for use as a meal replacement; nutritional shakes for use as a meal replacement; meal replacement snacks" in International Class 5 and "sauces" in International Class 30. Nestlé hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1063(a).

#### **The Parties and the Marks**

1. Nestlé is a corporation organized under the laws of Switzerland, with its principal place of business located at Case Postale 353, 1800 Vevey, Switzerland.

- 2. Nestlé is the world's leading nutrition, health and wellness company, with many internationally-recognized brands, including ice cream, dairy, and candy brands. Through its affiliates, Nestlé has developed a high degree of fame in its SKINNY COW brand, through the use of SKINNY COW, THE SKINNY COW, GET THE SKINNY, and other SKINNY marks, in connection with a broad range of food and dairy products, including candy, low fat ice cream, chocolate, milk, and frozen confections.
- 3. Nestlé is the owner of several federal registrations incorporating the word "SKINNY," including but not limited to the marks SKINNY COW and GET THE SKINNY, claiming "ice cream, low fat ice cream, low fat ice cream sandwiches, and frozen confections" and "candy; chocolate confections" in International Class 30 and "milk" in International Class 29. Nestlé is also the owner of several pending trademark registrations incorporating the word "SKINNY," including but not limited to SKINNY COW, claiming "milk-based beverages; flavored milk-based beverages" in International Class 29.
- 4. A list of Nestlé's SKINNY COW trademarks in the U.S. is attached hereto as <a href="Exhibit A"><u>Exhibit A</u></a> (collectively referred to as the "SKINNY COW Marks").
- 5. As a result of extensive use, advertising, and promotion, the SKINNY COW Marks have become well-known as distinctive indicators of the origin of Nestlé and its affiliates' goods and services and have become a valuable symbol of their goodwill.
- 6. The SKINNY COW Marks constitute a series or family of marks that are owned by and in the name of Nestlé and its affiliates. The earliest SKINNY COW trademark for use in connection with "low fat ice cream" was filed on April 21, 1999 and registered on February 29, 2000 (incontestable).

- 7. Upon information and belief, applicant BB Endeavors LLC ("BB Endeavors") is a corporation organized under the laws of New York, with its principal place of business at P.O. Box 2088 New York, New York 10013.
- 8. BB Endeavors' application Serial No. 85/302,689 ("the Skinnygirl Application") is highly similar in sight, sound and meaning to the SKINNY COW Marks and therefore creates a clear commercial impression identical to that of the SKINNY COW Marks.
- 9. The Skinnygirl Application claims goods highly similar, if not identical, to those offered by Nestlé under its SKINNY COW Marks.

# <u>Likelihood of Confusion with Nestlé's Registered SKINNY COW Marks</u> <u>Section 2(d), 15 U.S.C. § 1052(d)</u>

- Nestlé repeats and re-alleges each and every allegation set forth in Paragraphs 1-
- 11. Nestlé is the owner of the registrations and applications for the SKINNY COW Marks attached hereto as Exhibit A.
- 12. Nestlé's rights in its SKINNY COW Marks date back to at least as early as April 1999.
- 13. The filing date of the Skinnygirl Application is April 22, 2011, and the application is based on an intent to use the mark in U.S. commerce. Nestlé therefore has rights in the SKINNY COW Marks, based on its use and registrations, prior to BB Endeavor's earliest claimed priority date.
- 14. The Skinnygirl Application, dominated by the term "SKINNY," is visually and phonetically nearly identical to the SKINNY COW Marks. BB Endeavors' use of the term SKINNY is also identical in meaning to that of Nestlé's: to promote dieting, weight loss, or

health. The respective marks are therefore highly similar, if not identical, in sight, sound, meaning, and overall commercial impression.

- 15. The Skinnygirl Application claims nutritional bars for use as a meal replacement, nutritional shakes for use as a meal replacement, meal replacement snacks, and sauces. Nestlé's SKINNY COW Marks claim a broad range of food and dairy products for health-conscious consumers, including candy, chocolate confections, ice cream, low fat ice cream, low fat ice cream sandwiches, milk, and frozen confections. Thus, the parties' claimed goods and services, as well as the relevant consumers and channels of trade, are highly similar, if not identical.
- 16. The highly similar, if not identical, nature of the SKINNY COW Marks and the Skinnygirl Application in sight, sound, meaning, and overall commercial impression is therefore particularly pronounced given the highly similar, if not identical, nature of the goods and services offered by the parties.
- 17. BB Endeavors' junior use of an identical branding strategy and adoption of a highly similar, if not identical, mark for use in connection with highly similar, if not identical, goods wholly overlaps and duplicates Nestlé's SKINNY COW Marks, branding strategy, and underlying goods. This duplication will inevitably lead consumers to believe that Nestlé and its affiliates are the source of the products, or that BB Endeavors is affiliated with, endorsed by, sponsored by, or otherwise associated with Nestlé, all in violation of Nestlé's rights in its SKINNY COW Marks.
- 18. For the foregoing reasons, Nestlé believes and alleges that it is being and will be damaged by registration of the Skinnygirl Application Serial No. 85/302,689.

# <u>Likelihood of Confusion with Nestlé's Common Law Rights in the SKINNY COW Marks</u> Section 2(d), 15 U.S.C. § 1052(d)

- 19. Nestlé repeats and re-alleges each and every allegation set forth in Paragraphs 1-18.
- 20. Nestlé and its affiliates' use of the SKINNY COW Marks in U.S. commerce (and internationally) in connection with a broad range of food and dairy products, including candy, chocolate confections, ice cream, low fat ice cream, low fat ice cream sandwiches, milk, and frozen confections, has created substantial common law rights in the term "SKINNY." *See*Exhibit B attached hereto for a non-exhaustive, representative sample of the common law use of the SKINNY COW Marks.
- 21. As a result of such use in U.S. commerce, as well as other efforts by Nestlé and its affiliates, the SKINNY COW Marks have become distinctive source indicators of the candy, chocolate confections, ice cream, low fat ice cream, low fat ice cream sandwiches, and frozen confections offered by Nestlé, through its affiliates. Based on this use, Nestlé has not abandoned these common law rights.
- 22. Common law use of the SKINNY COW Marks began at least as early as January 1994.
- 23. The filing date of the Skinnygirl Application is April 22, 2011, and is based on an intent to use in U.S. commerce.
- 24. Nestlé's common law rights in the SKINNY COW Marks significantly predate BB Endeavor's earliest priority date.
- 25. The Skinnygirl Application, dominated by the term "SKINNY," is visually and phonetically nearly identical to the SKINNY COW Marks. BB Endeavors' use of the term SKINNY also has the same meaning as Nestlé's use: to promote dieting, weight loss, or health.

The respective marks are therefore highly similar, if not identical, in sight, sound, meaning, and overall commercial impression.

- 26. The Skinnygirl Application claims nutritional bars for use as a meal replacement, nutritional shakes for use as a meal replacement, meal replacement snacks, and sauces. Nestlé's SKINNY COW Marks claim a broad range of food and dairy products for health-conscious consumers, including candy, chocolate confections, ice cream, low fat ice cream, low fat ice cream sandwiches, milk, and frozen confections. Thus, the parties' claimed goods and services, as well as the relevant consumers and channels of trade, are highly similar, if not identical.
- 27. The highly similar, if not identical, nature of Nestlé's SKINNY COW Marks and the Skinnygirl Application in sight, sound, meaning, and overall commercial impression is therefore particularly pronounced given the highly similar, if not identical, nature of the goods and services offered by the parties.
- BB Endeavor's junior use of an identical branding strategy and adoption of a highly similar, if not identical, mark for use in connection with highly similar, if not identical, goods wholly overlaps and duplicates Nestlé's common law rights, branding strategy, and underlying goods. This duplication will inevitably lead consumers to believe that Nestlé and/or its affiliates are the source of the products, or that BB Endeavors is affiliated, endorsed, or sponsored by Nestlé, all in violation of Nestlé and its affiliates' common law trademark rights.
- 29. For the foregoing reasons, Nestlé believes and alleges that it is being and will be damaged by registration of the Skinnygirl Application Serial No. 85/302,689.

WHEREFORE, Nestlé respectfully requests that application Serial No. 85/302,689 be refused registration and judgment in the present opposition be entered in favor of Nestlé and against BB Endeavors, with prejudice.

Respectfully submitted,

SOCIÉTÉ DES PRODUITS NESTLÉ S.A

By: /A. John P. Mancini/
A. John P. Mancini
MAYER BROWN, LLP
1675 Broadway
New York, NY 10019
(212) 506-2295

Attorney for Opposer

#### **CERTIFICATE OF MAILING**

I hereby certify that, on this  $20^{th}$  day of July, 2012, I caused this Notice of Opposition to be sent via First Class Mail to:

BB Endeavors LLC P.O. Box 2088 New York, NY 10013

Diane J. Mason, Esq. Bullivant Houser Bailey PC 601 California Street, Suite 1800 San Francisco, CA 94108

By: / Jason L. White / Jason L. White

# **EXHIBIT A**

### Nestlé's SKINNY COW Trademarks

Mark	Image	Reg. No.	Reg. Date	Class
SKINNY COW	SKINNY COW	4031576	9-27-2011	30
GET THE SKINNY	GET THE SKINNY	3697164	10-13-2009	30
SKINNY COW	SkinnyCow	4026256	9-13-2011	30
THE SKINNY COW	The Skinny Cow	3403713	3-25-2008	30
THE SKINNY COW	The Skinny Cow	3360435	12-25-2007	29
THE "SKINNY COW"	The Symmy Cow?	2324506	2-29-2000	30
SKINNY COW	SKINNY COW	4165917	6-26-2012	30
SKINNY COW	SkinnyCow	4092390	1-24-2012	30

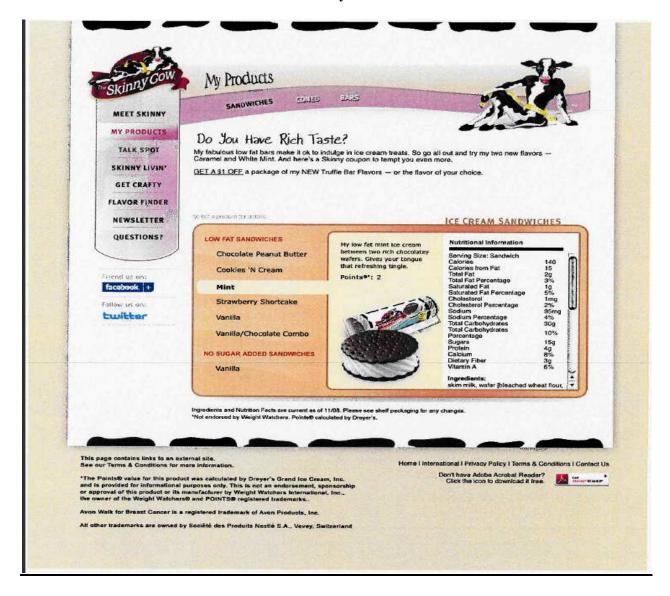
SKINNY COW	30	4092386	1-24-2012	30
	COW			
	Skinny			

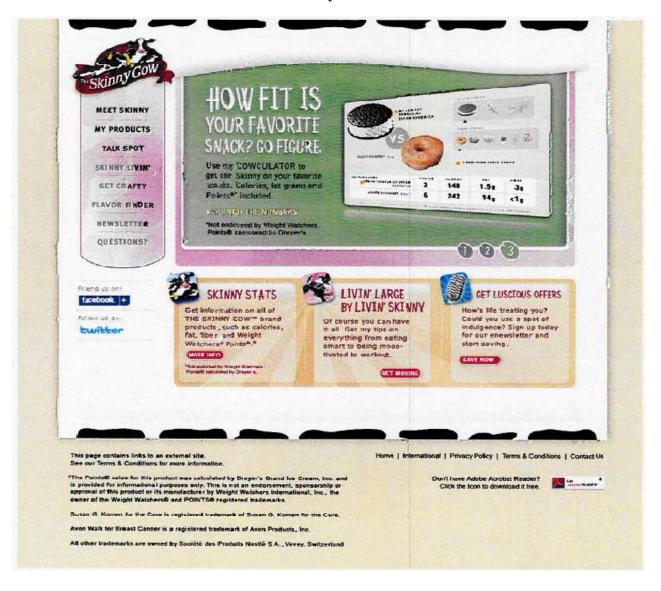
# Nestlé's SKINNY COW Pending Registrations

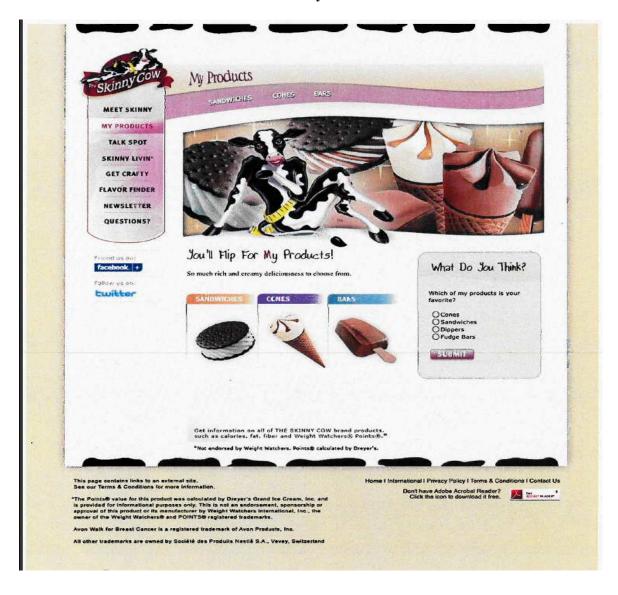
Mark	Image	Serial. No.	Filing. Date	Class
SKINNY COW	SkinnyCow	85268774	3-16-2011	29
SKINNY COW	Skinny Gow	85249923	2-23-2011	29
SKINNY COW	SKINNY COW	85246148	2-28-2011	29, 30
SKINNY COW	Skinny Cow	85268630	3-16-2011	29, 30
SKINNY COW	Skinny	85617973	5-6-2012	30

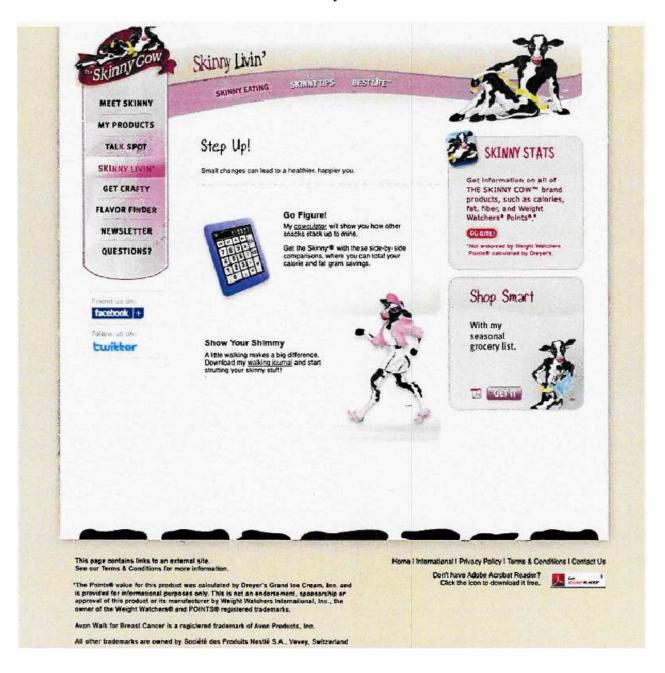
# **EXHIBIT B**

#### Nestlé's Common Law Use of the Skinny Cow Trademarks











#### Screenshot from www.facebook.com/TheSkinnyCow from July 19, 2012



#### Screenshot from www.twitter.com/theskinnycow from July 19, 2012

